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In re Application of	:
Zanco	: DECISION DENYING
Application No. 09/172,830	: PETITION
Filed: October 15, 1998	:
Attorney Docket No. 2348-348	:

This is a decision on the petition filed by facsimile transmission May 12, 2000 which is being treated as a petition (1) under 37 CFR 1.181(a)(3) requesting the Director's¹ supervisory intervention and consideration of the decision of the Group Director of March 23, 2000 which refused to withdraw the holding of abandonment or, in the alternative, (2) under 37 CFR 1.183 seeking waiver of the rules such that timely receipt is accorded to a previous facsimile transmission lacking a certificate of transmission.

The petitions are denied.²

BACKGROUND

A non final Office action was mailed July 30, 1999, which set a shortened statutory period for reply of three months. As no reply was received, and

¹The Patent and Trademark Office Efficiency Act (Pub. L. 106-113, 113 Stat. 1501A-572) effective March 29, 2000, titles the [former] Commissioner as the Director, United States Patent and Trademark Office.

² This decision may be treated as a final agency action within the meaning of 5 USC § 704 for purposes of seeking judicial review. See MPEP 1002.02.

no extensions of time were obtained under the provisions of 37 CFR 1.136(a), this application became abandoned by operation of law (35 USC 133) at midnight on October 30, 1999. A Notice of Abandonment was mailed February 25, 2000.

A petition to withdraw the holding of abandonment, based upon an alleged filing of a timely reply by way of facsimile transmission, was filed March 3, 2000, and was dismissed in the decision of the Group Director of March 23, 2000. The decision held that in the absence of a copy of an executed certificate of facsimile transmission which had been affixed to the alleged reply, the proffered facsimile transmission confirmation report was insufficient under 37 CFR 1.8 to warrant withdrawal of the holding of abandonment.

STATUTE AND REGULATION

35 U.S.C. § (6)(a) provides, in part, that:

The Commissioner . . . may, subject to the approval of the Secretary of Commerce, establish regulations, not inconsistent with law, for the conduct of proceedings in the Patent and Trademark Office.

35 U.S.C. 133 states:

Upon failure of the applicant to prosecute the application within six months after any action therein, of which notice has been given or mailed to the applicant, or within such shorter time, not less than thirty days, as fixed by the Commissioner in such action, the application shall be regarded as abandoned by the parties thereto, unless it be shown to the satisfaction of the Commissioner that such delay was unavoidable.

37 CFR 1.8(a) states in pertinent part that:

(a) Except in the cases enumerated in paragraph (a)(2) of this section, correspondence required to be filed in the Patent and Trademark Office within a set period of time will be considered as being timely filed if the procedure described in this section is followed. The actual date of receipt will be used for all other purposes.

(1) Correspondence will be considered as being timely filed if:

(i) The correspondence is mailed or transmitted prior to

expiration of the set period of time by being:

(A) Addressed as set out in § 1.1(a) and deposited with the U.S. Postal Service with sufficient postage as first class mail; or

(B) Transmitted by facsimile to the Patent and Trademark Office in accordance with § 1.6(d); and

(ii) The correspondence includes a certificate for each piece of correspondence stating the date of deposit or transmission. The person signing the certificate should have reasonable basis to expect that the correspondence would be mailed or transmitted on or before the date indicated.

37 CFR 1.8(b),(c) state in pertinent part that:

(b) In the event that correspondence is considered timely filed by being mailed or transmitted in accordance with paragraph (a) of this section, but not received in the Patent and Trademark Office, and the application is held to be abandoned or the proceeding is dismissed, terminated, or decided with prejudice, the correspondence will be considered timely if the party who forwarded such correspondence:

(1) Informs the Office of the previous mailing or transmission of the correspondence promptly after becoming aware that the Office has no evidence of receipt of the correspondence;

(2) Supplies an additional copy of the previously mailed or transmitted correspondence and certificate; and

(3) Includes a statement which attests on a personal knowledge basis or to the satisfaction of the Commissioner to the previous timely mailing or transmission. If the correspondence was sent by facsimile transmission, a copy of the sending unit's report confirming transmission may be used to support this statement.

(c) The Office may require additional evidence to determine if the correspondence was timely filed.

OPINION

With respect to review of the Director' decision:

Petitioner requests reconsideration of the decision of March 23, 2000 which refused to withdraw the holding of abandonment, based upon the lack of a showing that a certificate of facsimile transmission under 37 CFR 1.8 had

been affixed to documents alleged to have been transmitted to the PTO. Petitioner points to "convincing evidence" in support of his renewed petition: (1) a copy of the sending report indicating the transmission was "OK", (2) a declaration signed by counsel and his paralegal testifying as to the meaning of the "OK" confirmation, and the experience of the aforementioned persons with respect to the "OK" confirmation, and also averring to their knowledge that the transmission was sent.

The standard for review of the Group Director's decision is consideration of whether the decision maker was arbitrary or capricious, such that the decision was tantamount to an abuse of discretion. A review of the record fails to review any abuse of discretion. Likewise, the additional showing has been considered but does not warrant any modification of the decision of March 23, 2000. Simply put, the showing of record still lacks a copy of the certificate of facsimile transmission required by 37 CFR 1.8(b)(2). As such, the alleged reply was not "received" at the PTO within the meaning of 37 CFR 1.6.

Rather, the rules of practice provide an applicant with a remedy for the very situation that has arisen here. See 37 CFR 1.8(b). Nevertheless, the rules of practice require, for applicant to obtain relief under the rule, the following *direct* evidence: (1) the production of a certificate of facsimile transmission in addition to (2) a copy of the non-received correspondence, and (3) the copy of the sending unit's report confirming the transmission. Id.

The additional showings provided with the instant petition merely amount to the usual and ordinary procedures employed by counsel and his paralegal in sending facsimile transmissions, and indicate an intent to transmit a timely reply, but do not constitute the necessary *direct* evidence to warrant relief under 37 CFR 1.8. Rather, it is petitioner's burden to supply, under the rules of practice, sufficient direct evidence to establish that the reply in question was actually transmitted to the Office within the meaning of 37 CFR 1.8, such that it can be considered to have been "received" at the PTO within the meaning of 37 CFR 1.6. See, Krahn v. Commissioner, 15 USPQ2d 1823, 1825 (D.C. E Va 1990). In the absence of a copy of the certificate under 37 CFR 1.8, the usual and ordinary procedures employed at counsel's firm do not, as such, adequately provide the direct evidence necessary to meet petitioner's burden in this instance. Id. Petitioner's failure to make, or keep a copy of, the appropriate certificate of mailing or transmission under 37 CFR 1.8 does not satisfy the requirement of the rule, and, as such, does not warrant relief under the rule. Id.

With respect to extraordinary relief:

In the alternative, petitioner requests waiver of the rules of practice, or other extraordinary relief.

Suspension of the rules under 37 CFR 1.183 may be granted in an "extraordinary situation, when justice requires". The facts presented on the record do not establish an extraordinary situation. Petitioner has not established any special circumstances or equities that would require suspension of the rules in the interests of justice. In order for grant of any petition under 37 CFR 1.183, petitioner must show (1) that this is an extraordinary situation where (2) justice requires waiver of the rule. In re Sivertz, 227 U.S.P.Q. 255, 256 (Comm'r Pat. 1985). Petitioner has not shown that either condition exists in this case.

Equitable powers should not be invoked to excuse the performance of a condition by a party that has not acted with reasonable, due care and diligence. U.S. v. Lockheed Petroleum Services, 709 F.2d 1472, 1475 (Fed. Cir. 1983). Clearly, the employment *vel non* of a certificate of mailing under 37 CFR 1.8 is a circumstance that was entirely within the control of petitioner, and the apparent lack of proceeding under the rule is a circumstance that was entirely within the control of petitioner by the exercise of reasonable, due care and diligence. Assuming that the failure to employ a certificate of mailing or keep a copy thereof was due to clerical inadvertence or error, such is not a grounds for requesting waiver of the regulations. See In re Kabushiki Kaisha Hitachi Seisakusho, 39 USPQ2d 1319, 1320 (Comm'r Pat. 1994).

A party's inadvertent failure to comply with the requirements of a rule is not deemed to be an extraordinary situation that would warrant waiver of a rule under 37 CFR 1.183. See Honigsbaum v. Lehman, 903 F. Supp. 8, 37 USPQ2d 1799 (D.D.C. 1995) (Commissioner did not abuse his discretion in refusing to waive requirements of 37 CFR 1.10(c) in order to grant filing date to patent application, where applicant failed to produce "Express Mail" customer receipt or any other evidence that application was actually deposited with USPS as "Express Mail"), aff'd without opinion, 95 F.3d 1166 (Fed. Cir.1996); Nitto Chemical Industry. Co., Ltd. v. Comer, 39 USPQ2d 1778, 1782 (D.D.C. 1994) (Commissioner's refusal to waive requirements of 37 CFR 1.10 in order to grant priority filing date to patent application not arbitrary and capricious, because failure to comply with the requirements of

37 CFR 1.10 is an "avoidable" oversight that could have been prevented by the exercise of ordinary care or diligence, and thus not an extraordinary situation under 37 CFR 1.183); Vincent v. Mossinghoff, 230 USPQ 621 (D.D.C. 1985) (misunderstanding of 37 CFR 1.8 not unavoidable delay in responding to Office Action); Gustafson v. Strange, 227 USPQ 174 (Comm'r Pats. 1985) (counsel's unawareness of 37 CFR 1.8 not extraordinary situation warranting waiver of a rule); In re Chicago Historical Antique Automobile Museum, Inc., 197 USPQ 289 (Comm'r Pats. 1978) (since certificate of mailing procedure under 37 CFR 1.8 was available to petitioner, lateness due to mail delay not deemed to be extraordinary situation).

A standard principle of statutory construction is: *expressio unius est exclusio alterius* (the mention of one thing implies exclusion of another thing), namely absent legislative intent to the contrary, when a statute expressly provides a specific remedy for a specific situation, the statute is deemed to exclude other remedies for such situation. See National R.R. Passenger Corp. v. National Ass'n Of R.R. Passengers, 414 U.S. 453, 458 (1974); see also Botany Worsted Mills v. United States, 278 U.S. 282, 289 (1929) ("when a statute limits a thing to be done in a particular mode, it includes the negative of any other mode"). Since Congress has provided in Public Law 97-247 a specific scheme for the revival of abandoned applications (*i.e.*, the specific situations under which the PTO may revive an abandoned application and the specific requirements (fee amounts and standards) applicable to each specific situation), the creation of other schemes for the revival of any abandoned application would be inconsistent with the patent statute. Thus, the Commissioner's authority to revive an abandoned application is limited to that specified in the statutory scheme set forth in 35 U.S.C. §§ 41(a)(7), 111, 133, and 151. See Morganroth v. Quigg, 885 F.2d 843, 847, 12 USPQ2d 1125, 1128 (Fed. Cir. 1989) (the Commissioner lacks the authority to revive an application abandoned by termination of court proceedings because 35 U.S.C. §§ 41(a)(7), 133, or 151 do not provide for the revival of an application abandoned in such a manner). Moreover, the PTO will not normally consider an extraordinary remedy, when, as here, the statutes and rules already provide an avenue for obtaining the relief sought. See Cantello v. Rasmussen, 220 USPQ 664, 664 (Comm'r Pat. 1982).

Here, as the statutes and regulations provide petitioner with the means for seeking acceptance of the delayed reply by way of revival under 35 USC 41(a)(7) and 37 CFR 1.137, it is not necessary to also fashion an

extraordinary remedy, even assuming such would constitute a proper exercise of the rules.

DECISION

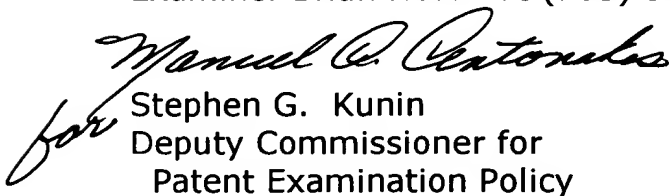
A review of the record indicates that the Group Director did not abuse her discretion or act in an arbitrary manner in her treatment of the petition of March 3, 2000. Each issue raised by the petition was treated fully, and the Group Director provided a reasonable basis to support her findings and conclusion that petitioner is not entitled to have the holding of abandonment withdrawn.

The petition under 37 CFR 1.181(a)(3) is granted to the extent that the Group Director's decision of March 23, 2000 has been reviewed, but is denied with respect to making any change therein. The holding of abandonment is proper and will not be withdrawn. This application remains abandoned.

Likewise, as petitioner has failed to make a showing of such extraordinary circumstances that would justify an equitable remedy, the rules of practice will not be waived in this instance. The request for extraordinary relief is denied.

Nevertheless, this file will be retained in the Office of Petitions to await any forthcoming petition to revive under 37 CFR 1.137(b). The mailing address for this office is: Assistant Commissioner for Patents, BOX DAC, Washington DC 20231. Alternatively, petitioner may send the petition by facsimile transmission, with fee authorization, marked to the attention of the Office of Petitions, at (703) 308-6916. The filing of a petition under 37 CFR 1.137(b) cannot be intentionally delayed.

Telephone inquiries related to this decision may be directed to Petitions Examiner Brian Hearn at (703) 305-1830.


for Stephen G. Kunin
Deputy Commissioner for
Patent Examination Policy